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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,846	12/27/2001	Tetsuya Nishimura	KPO123	8973
25271	7590	07/13/2004		EXAMINER
GALLAGHER & LATHROP, A PROFESSIONAL CORPORATION 601 CALIFORNIA ST SUITE 1111 SAN FRANCISCO, CA 94108				WONG, ERIC K
			ART UNIT	PAPER NUMBER
				2874

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/033,846	NISHIMURA, TETSUYA	
	Examiner	Art Unit	
	Eric Wong	2874	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

amendment

- 1) Responsive to ~~communication(s)~~ filed on 09 April 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 2 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 3-15 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>0504 / 0603 / 1203</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1, 5, 8 and 12 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by United States Patent Number 6,741,778 to Chan et al.

As to claims 1, and 8, Chan et al. discloses in figure 4 and abstract, an optical module comprising:

- A surface light receiving or a surface light emitting type optical element mounted on a predetermined substrate (30);
- At least one spacer mounted on said substrate (62).
- An optical fiber array having a plurality of optical fibers buried therein substantially in parallel with one another with a predetermined pitch therebetween, said optical fiber array being mounted to said substrate with said spacer interposed between the substrate and the optical fiber array such that the optical fibers are opposed to a plurality of light receiving elements or light

emitting elements of the optical element mounted on the substrate respectively, and said optical fiber array being mounted to said substrate with alignment between the end surfaces of the optical fibers, the light receiving elements or light emitting elements, and the substrate carried out active or passive alignment means,

- As to claims 3-4, Masataka discloses the fiber array is provided with engagement means with pin like holes (50).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5-7, and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al. as applied to claims 1 and 8 above, and further in view of United States Patent Number 5,383,118 to Nguyen.

Chan et al. discloses in figure 4 and abstract, an optical module with surfaces, spacers, alignment pins and passive alignment of a fiber block at a predetermined distance between the top of the active optical device and the coupler surface, but fails to explicitly disclose image recognition as an alignment means.

It is widely known in the art that passive alignment means include techniques such as image recognition as disclosed in the abstract of United States Patent Number 5,383,118 to Nguyen.

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It would have been obvious at the time the invention was made to a person having ordinary skill in the art to recognize that image recognition is a widely known technique for passive alignment of devices to keep optical losses to a minimum.

Information Disclosure Statement

6/28/03 and 12/22/03

6. The information disclosure statements(IDS) submitted on 05/10/2004 has been considered by the examiner and made of record (note the attached copy of form PTO-1449). It appears the reference in the prior art discloses image recognition means as well as a spacer between two surfaces of an optical component.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. United States Patent Number 6,759,687 to Miller et al. for a method of aligning an optical device.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Wong whose telephone number is 571-272-2363. The examiner can normally be reached on Monday through Friday, 830AM - 430PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on 571-272-2344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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HEMANG SANGHAVI
PRIMARY EXAMINER